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CHRISTIE, PARKER & HALE, LLP			BORISSOV, IGOR N	
PO BOX 7068			ART UNIT	
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			3639	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/585,025	Applicant(s) LINGLE ET AL.	
	Examiner Igor Borissov	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 and 47-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 and 47-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/23/2006 has been entered.

Response to Amendment

Amendment received on 3/23/2006 is acknowledged and entered. Claims 46 and 52-82 have been canceled. Claims 1 and 29 have been amended. Claims 1-45 and 47-51 are currently pending in the application.

Preliminary Note

For purposes of examination Examiner understands the phrase: "wherein the printing wizard determines top, center, or bottom offset " in claim 1, lines 6 and 7, as: "wherein the printing wizard determines *at least one of* top, center, or bottom offset ".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29-45 and 47-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 refers to an apparatus, and recites the following limitations: "a first GUI for printing a sample print including a symbol; and a second GUI for displaying a plurality of symbols for a users to select one of the displayed plurality of symbols matching the symbol printed on the sample print and based on the selected symbol,

determining a print offset”, which is confusing. It is not clear to what extent a GUI represents a structural element. Furthermore, the claim is written in means plus function format, which is confusing. It is not clear how a GUI can provide for “determining a print offset”. Furthermore, said limitation of “determining” indicates a method step, while the claim is directed to an apparatus. Moreover, so as the phrase “based on the selected symbol, determining a print offset” does not recite a structural element, it is not clear should it be given patentable weight. Furthermore, while the preamble of the claim refers to “an interactive online postage printing system”, the body of the claim does not provide any support or indication of said “online” or “postage” features. Therefore, the body of the claim does not correspond to the preamble, which is confusing.

Claim 30 recites the following limitation: “...further comprising a registration wizard including a GUI for specifying a payment method”, which is confusing. It is not clear what type of functionality is appeared to be claimed: a registration function; a specifying a payment method function; or both.

Claim 36 recites the limitation the server in the second line. There is insufficient antecedent basis for this limitation in the claim. As per language: “...so that the server can store the entered password and verify the password” see reasoning applied to claim 29.

Claim 37 recites the limitation “the server” in the second line. There is insufficient antecedent basis for this limitation in the claim.

Claims 38-40 recite the limitation “the installation wizard”. There is insufficient antecedent basis for this limitation in the claim.

Claims 44, 45, 47-51 recite the limitation “the printing wizard”. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 29 is rejected under 35 U.S.C. 102(b) as being anticipated by Rourke (US 5,384,886).

Independent claim.

W.R.T. Claim 29:

Rourke teaches a system for printing envelopes electronically, comprising a first GUI (see Fig. 11) for printing a sample print including a symbol (180, 186, 184, etc.), a second GUI (see Figs. 12-13, 15-16, 18) for displaying a plurality of symbols for a users to select one of the displayed plurality of symbols matching the symbol printed on the sample print (see 160-3 in Supra Figs.). Information as to: "and based on the selected symbol, determining a print offset" indicates an intended use of the system, and does not recite a structural elements, and, therefore, is not given patentable weight.

MPEP 2106 (II) (C) states: "Language that suggests or makes optional but does not require steps to be performed or *does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*"

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of Claim 29 are disclosed in Rourke as described herein. Also, as described, the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (US 5,825,893) in view of Slayden et al. (US 5,680,629) and further in view of Ryan, Jr. et al. (US 5,871,288).

Independent claim

W.R.T. Claim 1:

Kara discloses a system for printing postage meter stamp, comprising:
a client subsystem for interfacing with a user comprising:
a GUI for installing software for printing (a printing wizard) the value bearing item (see Figs. 2-8 and the description thereof);
a GUI for registering the user in the system (see Id.);
a printing wizard for managing the printing of the VBI (see Fig. 8); and
a server subsystem for transmitting an authorization message to the client subsystem for authorizing the client subsystem to print the VBI while the server subsystem is in communication with the client subsystem (see Figs. 1 and 10; col. 3, line 64 - col. 4, line 15; see Claim 1).

However, Kara does not specifically disclose that the printing wizard determines top, center, or bottom offset and prints a quality assurance indicium, wherein the printing wizard includes a user interface for accepting user feedback about the printed quality assurance indicium, and wherein if the users feedback input in the user interface indicates that the quality assurance indicium prints correctly, the printing wizard then prints the VBI.

Slayden et al. teaches a printing wizard, wherein the wizard determines top, center or bottom offset and prints the document (see Fig. 9 for the print-preview wizard; col. 17, lines 44-52. After reviewing the documents (if the document shows any offset), the user can always go back to page-set-up program so as to determine top, center or bottom offset and ultimately print the document. Microsoft like this reference or other document producing program ALREADY include the printing wizard that enables the user to determine top, center or bottom offset and print the document without further charging the user. Slayden is simply cited to show how this well-known printing wizard works and it can be incorporated into the system of Kara to help the user to determine top, center, or bottom offset and prints the VBI.).

Ryan, Jr. et al. (Ryan) teaches a system for generating and printing information based indicia in postage metering system, wherein a user prints a test print of an indicia (bar code), and inspects the print for errors. If quality of the print is acceptable, the user then proceeds with printing (col. 3, lines 16-28).

It would have been obvious at the time the invention was made to one having ordinary skill in the art to incorporate the printing wizard, which determines top, center or bottom offset and prints the document, into the system of Kara, as taught by Slayden et al., and it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara and Slayden et al. to include that if the users indicates that the quality assurance indicium prints correctly, the printing wizard then prints the desired image, as disclosed in Rourke, because it would advantageously provide for compliance of the mailer with proper placement of the postage indicia, as required by C.F.R. 39, Part 111 and USPS Publication No. 25 "Designing Letter Mail" (August 1995), which discloses the USPS established guidelines directed to the margins, label sizes, and placement (location) of the Postal Indicia, as well as placement of other characteristics, on mail pieces.

Dependent claims

W.R.T. Claim 2: The modified system of Kara further discloses the system, wherein the VBI bears postage value (see Figs. of Kara);

W.R.T. Claims 3-4:

The modified system of Kara discloses the invention as cited above, but does not specifically disclose the subject matters of Claims 3-4, and 6: wherein the VBI is a ticket; the VBI is one or more of a coupon, a voucher and a check.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to: make a ticket, one or more of a coupon, a voucher and a check; and make changes to the user's information because Applicant has not disclosed that having the limitations of Claims 3-4 provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified system of Kara because the modified system of Kara discloses the system for registration, installation and printing the VBI, wherein the various GUI are utilized to execute the registration, installation and printing process, and it is well known in the art to include the other types of GUIs for executing the features as specified in Claims. Therefore, it would have been an obvious matter of design choice to further modify the modified system of Kara such that the system can print a various types of VBI, for the purpose printing ticket, a coupon, a voucher and a check.

Furthermore, Kara teaches:

W.R.T. Claim 5: The modified system of Kara further discloses the system, wherein the client subsystem includes a GUI for specifying a payment method (see Figs. 4A-B, 8 in Kara);

W.R.T. Claim 6: The modified system of Kara further discloses the system including a GUI for making changes to the user's information (see Fig. 9 for a typical window based GUI in Slayden et al.);

W.R.T. Claim 7: The modified system of Kara further discloses the system, wherein the client subsystem includes a GUI for displaying the user information, account information (see Figs. 4A-B, 8 in Kara);

W.R.T. Claim 8: The modified system of Kara further discloses the system, wherein the account information includes an amount of credit left in the account (see Id.);

W.R.T. Claim 9: The modified system of Kara further discloses the system, wherein the client subsystem includes a GUI for specifying an address book from a plurality of address books to print the address (see Fig. 8 and the description thereof in Kara);

W.R.T. Claim 10: The modified system of Kara further discloses the system, wherein the client subsystem includes a GUI for entering a password to store the entered password and verify the password in the server subsystem (see Supra registration and installation);

W.R.T. Claim 11: The modified system of Kara further discloses the system, wherein the server subsystem includes an address matching module for verifying an address entered by the user (see Fig. 10 in Kara);

W.R.T. Claim 12: The modified system of Kara further discloses the system, wherein the GUI for installing software includes a GUI for the user to specify the type of connection to the computer network (see col. 9, lines 8-10 in Kara);

W.R.T. Claim 13: The modified system of Kara further discloses the system, wherein the GUI for installing software includes a GUI for reporting error messages to the user (see Figs. depicting "warning messages" in Kara);

W.R.T. Claim 14: The modified system of Kara further discloses the system, wherein the GUI for installing includes a GUI for canceling an installation process (see Fig. 2 for installation process. Obviously, the user can cancel the installation by not following the process, e.g. entering wrong information, not inserting a pertinent disk or not connecting the pertinent device in Kara);

W.R.T. Claim 15: The modified system of Kara further discloses the system, wherein the GUI for registering the user includes a GUI for entering user information (see Supra installation and registration);

W.R.T. Claim 16: The modified system of Kara further discloses the system, wherein the GUI for registering includes a GUI for offering the user a plurality of service plan and for selecting by the user a service plan for choice (e.g. see Fig. 8 for the service plan or choice that the user can select in Kara);

W.R.T. Claim 17: The modified system of Kara further discloses the system, wherein the GUI for registering includes a GUI for reporting error messages to the user (see Fig. 7, for the messages in Kara);

W.R.T. Claim 18: The modified system of Kara further discloses the system, wherein the GUI for registering includes a GUI for canceling a registering process (see Supra the cancellation process for installation);

W.R.T. Claim 19: The modified system of Kara further discloses the system, wherein the GUI for managing the printing includes a GUI for displaying a graphical image of the VBI (see Fig. 8 in Kara);

W.R.T. Claim 20: The modified system of Kara further discloses the system wherein the GUI for managing includes a first GUI for printing a quality assurance VBI on an envelope (typical window word based applications can perform this);

W.R.T. Claim 21: The modified system of Kara further discloses the system wherein the GUI for managing includes a second GUI for displaying selectable choices of a printed quality assurance VBI (see Id.);

W.R.T. Claim 22: The modified system of Kara further discloses the system wherein the GUI for managing includes a GUI for troubleshooting selected printing options (see Typical window based applications in Slayden et al.);

W.R.T. Claim 23: The modified system of Kara further discloses the system, wherein the GUI for managing includes a GUI for providing envelope options (see Figs. 8-9 in Kara);

W.R.T. Claim 24: The modified system of Kara further discloses the system, wherein the GUI for managing includes a GUI for providing label options (see Fig. 8 in Kara);

W.R.T. Claim 25: The modified system of Kara further discloses the system, wherein the GUI for managing includes a GUI for providing postage options (see Id.);

W.R.T. Claim 26: The modified system of Kara further discloses the system wherein the GUI for managing includes a GUI for reporting error messages to the user (see Supra Window applications);

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W.R.T. Claim 27: The modified system of Kara further discloses the system, wherein the GUI for managing includes a GUI for canceling a print process (see Fig. 8 for the typical printing GUI that must include the cancel option {under the "File" or other Dropdown window option} for the print process in Kara); and

W.R.T. Claim 28: The modified system of Kara further discloses the system, wherein the GUI for specifying a payment method includes a GUI for displaying credit card information field to be filled by the user when the user specifies a credit card for the payment method (col. 11, lines 47-53 in Kara).

Claims 30-45 and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rourke in view of Kara.

Dependent claims

W.R.T. Claim 30: Rourke teaches all the limitations of claim 30, except specifically teaching a registration wizard including a GUI for specifying a payment method.

Kara discloses a system for printing postage meter stamp, comprising a GUI for registering the user in the system, wherein the registration wizard includes a GUI for specifying a payment method (see col. 11, lines 25-53; Figs. 4A-B; 8 in Kara).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rourke to include that said system includes registration wizard including a GUI for specifying a payment method, as disclosed in Kara, because it would advantageously allow to prevent fraud, and provides convenience to the user by allowing a flexibility of payment.

W.R.T. Claim 31: Kara teaches said system, wherein the GUI for specifying a payment method includes a GUI for displaying credit card information field to be filled by the user (col. 11, lines 47-53 in Kara). The motivation to combine the references would be to employ the convenient and well known payment method.

W.R.T. Claim 32: Kara teaches said system, wherein the registration wizard includes a GUI for making changes to the user's information (see typical window applications MUST perform this task). The motivation to combine the references would

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be to accommodate possible users mistakes made during entering information into the system.

W.R.T. Claim 33: Kara teaches said system, wherein the registration wizard includes a GUI for displaying the user information including account information (see Fig. 3 in Kara). The motivation to combine the references would be to provide convenience to the customer.

W.R.T. Claim 34: Kara teaches said system, wherein the account information includes an amount of credit left in the account (see Figs. 4A-B, 8 in Kara). The motivation to combine the references would be to provide convenience to the customer.

W.R.T. Claim 35: Kara teaches said system, wherein the installation wizard includes a GUI for specifying an address book from a plurality of address books to print the address (see Supra Claim 9). The motivation to combine the references would be to provide convenience to the customer.

W.R.T. Claim 36: Kara teaches said system, wherein the registration wizard includes a GUI for entering a password to store the entered password and verify the password in the server subsystem (see Supra Claim 10). The motivation to combine the references would be to prevent fraud.

W.R.T. Claim 37: Kara teaches said system, wherein the server subsystem includes an address matching module for verifying an address entered by the user (see Supra Claim 11). The motivation to combine the references would be to prevent fraud.

W.R.T. Claim 38: Kara teaches said system, wherein the installation wizard includes a GUI for the user to specify the type of connection to the computer network (see Supra Claim 12). The motivation to combine the references would be to ensure the functionalities of the system.

W.R.T. Claim 39: Kara teaches said system, wherein the installation wizard includes a GUI for reporting error messages to the user (see Supra Claim 13). The motivation to combine the references would be to ensure the functionalities of the system.

W.R.T. Claim 40: Kara teaches said system, wherein the installation wizard includes a GUI for canceling an installation process (see Supra Claim 14). The motivation to combine the references would be to provide flexibility to the user.

W.R.T. Claim 41: Kara teaches said system, wherein the registration wizard includes a GUI for entering user information (see Supra Claim 15). The motivation to combine the references would be to ensure the functionalities of the system.

W.R.T. Claim 42: Kara teaches said system, wherein the registration wizard includes a GUI for offering the user a plurality of service plans and for selecting by the user a service plan for choice (see Supra Claim 16). The motivation to combine the references would be to provide flexibility to the user.

W.R.T. Claim 43: Kara teaches said system, wherein the registration wizard includes a GUI for reporting error messages to the user (see Supra Claim 17). The motivation to combine the references would be to ensure the functionalities of the system.

W.R.T. Claim 44: Kara teaches said system, wherein the printing wizard includes a GUI for displaying a graphical image of a sample postage on an envelope (see Fig. 11 in Rourke). The motivation to combine the references would be to ensure the functionalities of the system.

W.R.T. Claim 45: Kara teaches said system, wherein the printing wizard includes a first GUI for printing a quality assurance VBI (see Supra Figs. of Rourke). The motivation to combine the references would be to ensure the functionalities of the system.

W.R.T. Claim 47: Kara teaches said system, wherein the printing wizard includes a GUI for troubleshooting selected printing options (see Id.). The motivation to combine the references would be to ensure the functionalities of the system.

W.R.T. Claim 48: Kara teaches said system, wherein the printing wizard includes a GUI for providing envelope options (see Supra Claim 23 and Supra Figs. of Rourke). The motivation to combine the references would be to provide flexibility to the user.

W.R.T. Claim 49: Kara teaches said system, wherein the printing wizard includes a GUI for providing label options (see Supra Claim 24). The motivation to combine the references would be to provide flexibility to the user.

W.R.T. Claim 50: Kara teaches said system, wherein the printing wizard includes a GUI for providing postage options (see Supra Claim 25). The motivation to combine the references would be to provide flexibility to the user.

W.R.T. Claim 51: Kara teaches said system, wherein the GUI for managing includes a GUI for reporting error messages to the user (see Supra Claim 26). The motivation to combine the references would be to ensure the functionalities of the system.

Response to Arguments

Applicant's arguments with respect to claims 1-45 and 47-51 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

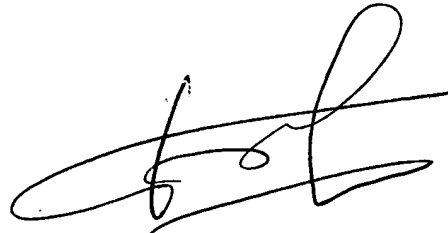
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB

6/05/2005

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', with a large, stylized loop at the end.

IGOR N. BORISSOV
PRIMARY EXAMINER